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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,641	07/07/2003	John A. Dispenza	4167-122CON	7628
7590	05/21/2004		EXAMINER	
Lance J. Lieberman, Esq. Cohen, Pontani, Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176			LEE, JINHEE J	
			ART UNIT	PAPER NUMBER
			2831	
DATE MAILED: 05/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/614,641	DISPENZA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jinhee J Lee	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 February 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: allowable subject matter.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group II claims 11-21 in Paper Dated 2/17/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for forming an electrically shielded panel, does not reasonably provide enablement for bonding an electrically conductive elastomer with the electrically non-conductive thermoplastic. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification, as originally filed, fails to provide support for an uncured electrically non-conductive thermoplastic to bond with an electrically conductive elastomer. The specification, as originally filed, provides support for fully curing (liquid to solid) the thermoplastic, not partly solidifying. If the thermoplastic is partly solidified, it will not be able to form a rigid

thermoplastic and maintain its form during the steps c and d. During step c, the articulating process will change the shape or distort the partly cured thermoplastic due to the vacating process. During step d, due to the high pressure that is being used to inject an elastomer into the second cavity will mix the elastomer with the partly solidified thermoplastic. Thus, the integrity of the panel will be compromised, and it will not form a planar conductive shield.

5. Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 line 1, the limitation "forming during a single forming operation" renders the claim vague and indefinite. The body of the claim recites a multiple forming operation for forming a panel, not a single forming operation. Further, the claim does not recite "two-step". In addition, there is no mention anywhere as to whether the tool is one-piece or multiple-pieces. If it is not a multiple-pieces, how can a mold have a cavity with first and second parts?

Claim 11, clarify where the thermoplastic is fully cured or partly solidified. How is it possible for the thermoplastic to maintain its form and shape during the steps c and d?

***Allowable Subject Matter***

6. Claims 11-21, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action without adding new matter.

The following is a statement of reasons for the indication of allowable subject matter: Prior arts do not teach or suggest the combination of steps of introducing into the second part of the tool cavity an electrically conductive elastomer that bonds with the electrically non-conductive thermoplastic in the first part of the cavity when thermoplastic is partly solidified.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Salter et al. and Peng et al. are cited to show various method of forming thermoplastic.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M, T, Th and F at 6:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on 571-272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2831

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jjl

*Dean A. Reichard 5/13/04*  
DEAN A. REICHARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800